Application Number 09/876,432
Responsive to Office Action mailed February 20, 2007

REMARKS

This amendment is responsive to the Office Action dated February 20, 2007. Applicant has amended claim 83 and canceled claim 42–44. Claims 1, 3–8, 10–13, 15–24, 39–41, 45–49, and 75–102 are pending.

Allowable Subject Matter

In the Office Action, the Examiner objected to claims 17 and 24 as including subject matter that would be allowable if rewritten in independent form. Applicant thanks the Examiner for the indication of allowability.

Claim Rejection Under 35 U.S.C. § 103

Claims 1, 3–8, 10–12, 13, 15, 16, 18–23, 75–78, and 80–94

In the Office Action, the Examiner rejected claims 1, 3–8, 12, 13, 15, 16, 18–23, 75–78, 80–84 and 87–94 under 35 U.S.C. 103(a) as being unpatentable over Garber et al. (US 6,232,870) ("Garber") in view of Davidsson (US 6,934,718). In the Office Action, the Examiner also rejected claims 10, 11, 85 and 86 under 35 U.S.C. 103(a) as being unpatentable over Garber in view of Davidsson as applied to claims 8 and 83, and further in view of Beauchamp (US 6,886,011). Applicant respectfully traverses the rejections. Even when combined, the applied references fail to disclose or suggest all of the elements defined by Applicant's claims.

Claims 1, 8, 18, 75, 91

For example, independent claims 1, 8, 18, 75, 91 require that the step of using the RFID reader to interrogate at least one RFID tag associated with an item of interest to obtain information is performed _after_ selecting a category of items using a user interface associated with an RFID reader. That is, claims 1, 8, 18, 75, 91 require that a category of items is selected prior to interrogation of the RFID tag(s) from which information is obtained. In the Office Action, the Examiner stated that Garber discloses programming a portable RFID device with a unique identifier of an item the operator wishes to locate. The Examiner acknowledged that Garber "fails to teach that the inputted information is a category."[1] In this statement, the Examiner appears to overlook that step (a) requires _selecting_ a category _with a user interface_ associated

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[1] Office Action dated February 20, 2007, at page 4.

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with an RFID reader, not merely programming information. In contrast to the Examiner's
remarks, statically programming information (as taught by Garber) does not teach the operation
of selecting a category with a user interface, as required by Applicant's claim. Specifically,
Garber teaches that a unique identifier for each desired item may be stored as a list in a reserved
memory location in the handheld device. Garber provides no indication that the unique identifier
is later "selected" from the programmed list using a user interface prior to interrogating the tags.
In addition, Garber provides no suggestion that the list of identifiers is presented to the user via a
user interface for selection prior to interrogating. Quite the opposite, when scanning the items,
Garber tries to match to any of the identifiers from list of identifiers, and does not even allow the
user to select particular identifiers with a user interface. Since Garber provides no teaching or
suggestion of selecting a category of items, Garber correspondingly fails to teach or suggest using
the RFID reader to interrogate an RFID tag after selecting the category.

In view of the deficiencies of Garber acknowledged by the Examiner, the Examiner cited
Davidsson. Davidsson describes a web browser configured to categorize book-marked web
pages. In contrast to the requirements of claims 1, 8, 18, 75, 91, Davidsson teaches that the web
page is obtained prior to the user selecting one or more categories for the web page. In
particular, Davidsson states that "web page A is displayed in window 38, ready to be
bookmarked."[2] Neither Davidsson not Garber, alone or in combination, teaches or suggests
selecting a category of items using a user interface associated with an RFID reader, and after
selecting the category, using the RFID reader to interrogate at least one RFID tag associated with
an item of interest to obtain information associated with the item of interest, wherein the item of
interest is not currently associated with the selected category, and thereafter associating the
obtained information with the selected category. Quite the contrary, Davidsson clearly describes
obtaining a web page prior to selecting a category for the web page, and Garber provides no
selection operation whatsoever prior to interrogating RFID tags.

In the Office Action, the Examiner stated that Garber teaches "that the item of interest is
not currently associated because Garber teaches the association is being determined by the
comparison."[3] However, contrary to the Examiner's assertion, the items in the Garber system are

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[2] Davidsson, col. 5, ll. 38–39.
[3] Office Action dated February 20, 2007, at page 4.

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already associated with the unique identifier. In fact, the unique identifiers are read by the RFID reader as RFID-tagged items are interrogated. Each identifier read by the RFID reader is then compared to a list of items stored in the reader memory.[4] Thus, an association of the item with the unique identifier is not being made at the time of comparison in the Garber system, as suggested by the Examiner. If this were the case, no comparison could be made between the unique identifiers read from interrogated items and the unique identifiers within the list.

As another example, independent claim 8 requires using the RFID reader to <u>automatically</u> categorize the information obtained in step (b) with at least one of the categories selected in step (a), and wherein information necessary to categorize each RFID-tagged item may be obtained from the RFID tag itself. As acknowledged by the Examiner, Garber fails to teach or suggest selecting a category and categorizing the information with at least one of the categories. Thus, Garber similarly fails to teach using the RFID reader to <u>automatically</u> categorize the information.

Davidsson provides no teaching or suggestion that the web browser <u>automatically</u> categorizes web pages <u>using information obtained from the web pages themselves</u>. Rather, the user must interact with the web browser and manually select the categories that the user wishes to associate with particular web pages. Therefore, even when combined, Davidsson in view of Garber provides no RFID device capable of automatically categorizing information received from an RFID-tagged item within multiple (at least two) pre-selected categories.

Similarly, independent claims 18 and 91 require <u>using the RFID reader</u> to categorize information and ignore any RFID-tagged-item that may not be categorized in any of the categories, wherein the **RFID reader** determines which of the RFID-tagged-items may not be categories in any of the categories. The Examiner states that Davidsson teaches that the user may bookmark a web page without selecting a category with which to categorize the web page. However, unlike the features recited by claims 18 and 91, in the Davidsson system <u>the user</u> makes the decision not to categorize the web page. Applicant also submits that bookmarking a web page without an associated category does not teach or suggest <u>ignoring</u> any RFID-tagged-item that may not be categorized in any category. In particular, the Davidsson system does not "ignore" the uncategorized web page, because an affirmative action is taken by bookmarking the web page, and data relating to the web page is stored in the process of bookmarking the web

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[4] Garber, col. 16, ll. 41–45.

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page. Consequently, Davidsson provides no teaching pertinent to using an RFID reader to categorize information, and using the RFID reader to ignore any RFID-tagged-item that may not be categorized in any of the categories, wherein in step (d) the RFID reader determines which of the RFID-tagged-items may not be categorized in any of the categories, as recited by independent claims 18 and 91.

As another example, claim 75 recites selecting a category of items using a user interface, wherein a category is a group of items that possess specified attributes and represents a portion of an entire group of items having associated RFID tags." In the Office Action, the Examiner stated regarding Davidsson's discussion of categorizing web pages in terms of both sports and newspapers that "the categories sports and newspaper are specified attributes and represents a portion of an entire group of items."[5] However, the web page categories of sports and newspapers are not groups of physical items that represent a portion of an entire group of physical items having associated RFID tags. Rather, in the context of Davidsson, these are general categories in which web pages may be categorized. Web pages are not physical items having associated RFID tags. In contrast, claim 75 requires selecting a category composed of a group of items that possess specified attributes. For example, "non-fiction books" may be a category of a group of items that possess specified attributes and represents a portion of an entire group of items (e.g., all books) having associated RFID tags.

Claim 76

Similarly, independent claim 76 requires selecting a category of items using a user interface associated with a computer, and designating one or more attributes of items in that category to define the category, obtaining a list of at least one RFID-tagged item, and automatically associating information related to the at least one item with the selected category using the designated attributes, wherein the information is obtained by interrogating the RFID tag associated with the at least one item. As explained above, Garber provides no teaching or suggestion of associating information with a selected category, automatically or otherwise. In addition, Davidsson provides no teaching or suggestion of automatically categorizing web pages. Moreover, Garber and Davidsson both fail to teach or suggest automatically associating information related to the at least one item with the selected category using the designated

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[5] Office Action dated February 20, 2007, page 5.

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attributes, wherein the information is obtained by interrogating the RFID tag associated with the at least one item, as further required by claim 76.

Claim 83

As a further example, independent claim 83 requires selecting at lest two categories of items using a user interface, interrogating an RFID tag associated with at least one RFID-tagged item to obtain information related to the at least one item, and, as a primary operation, categorizing the information related to the at least one item(s) in at least one of the categories.

As stated above, Garber provides no teaching of selecting a category using a user interface. The Examiner also stated, "Since Garber obtains the unique identifier of items by the RF reader, the information necessary to categorize each RFID-tagged item is the unique identifier, which is obtained from the RFID tag itself."[6] This contradicts the Examiner's subsequent acknowledgement that Garber fails to teach that a category is selected and associated, and further illustrates the Examiner's contrivance in relying on the Garber reference as teaching these elements of Applicant's claims.

Claim 83 also requires, simultaneously with the primary operation of categorizing information in step (c), using the information obtained by the interrogation for performing a background inventory operation of determining the presence or absence of the items in the storage area and updating an inventory database to reflect the determined presence or absence of the items in the storage area. Neither Davidsson nor Garber, alone or in combination, teaches or suggests this feature. The Examiner acknowledges that Garber fails to teach or suggest updating an inventory database to reflect the determined presence or absence of the items in the storage area. Nonetheless, the Examiner asserts that one of ordinary skill would have found it obvious to modify the Garber system to include this feature, because Garber discloses that the user may input a new status of an article into a hand-held RFID device. The Examiner's statements overlook the requirement of claim 83 of using the information obtained by the interrogation for performing the determining and updating as a background inventory operation. Garber's teaching of allowing a user to input a status of an item requires an independent, active step by the user, and fails to teach or suggest modification of the Garber system to simultaneously use the same information obtained by the interrogation for performing the recited background inventory

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[6] Office Action dated February 20, 2007, at page 4 (emphasis added).

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operation. Thus, one of ordinary skill in the art would not have found such a modification of the Garber system obvious based on the cited teachings of Garber.

Of course, the claims dependent on independent claims 1, 8, 18, 75, 76, 83, and 91 incorporate all of the limitations of the respective base claims, and therefore are patentable for at least the reasons expressed above.

For at least these reasons, the Examiner has failed to establish a prima facie case for non-patentability of Applicant's claims 1, 3–8, 10–12, 13, 15, 16, 18–23, 75–78, and 80–94 under 35 U.S.C. 103(a). Withdrawal of this rejection is requested.

Claims 39–47

In the Office Action, the Examiner rejected claims 39–47 under 35 U.S.C. 103(a) as being unpatentable over Garber. Applicant respectfully traverses the rejection. The applied reference fails to disclose or suggest the inventions defined by Applicant's claims, and provides no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

Claims 39–41

For example, independent claim 39 requires interrogating RFID tags, using the information obtained in the interrogation step for performing a primary operation of determining whether the items are in a predetermined order within a physical storage area, and simultaneously with the primary operation of determining whether the items are in a predetermined order within the storage area, using the information obtained by the interrogation in step (a) for performing a background inventory operation of determining the presence or absence of the items in the storage area and updating an inventory database to reflect the determined presence or absence of the items in the storage area. Independent claims 40 and 41 recite similar limitations, with the primary operation of claim 40 being searching for certain items on a predetermined search list, and the primary operation of claim 42 being checking items into or out of a physical storage area.

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In the Office Action, the Examiner acknowledged that Garber fails to disclose or suggest simultaneously with the primary operation of determining whether the items are in a predetermined order within the storage area in step (b), using the information obtained by the interrogation in step (a) for performing a background inventory operation of determining the presence or absence of the items in the storage area and updating an inventory database to reflect the determined presence or absence of the items in the storage area, as recited by independent claim 39. Nonetheless, the Examiner stated that Garber discloses that some books are grouped as a set of associated items, such as an encyclopedia, which are in alphabetical order. Garber describes that the RFID device could be used to determine whether all members of a set of associated items are present together. The Examiner asserted that it would be necessary to perform an order determination to determine which exact book or volume is missing from the set.[7] The Examiner concluded that it would have been obvious to one of ordinary skill in the art to modify the teachings of Garber to simultaneously perform the two operations because one operation necessitates the determination of the other. Applicant respectfully disagrees.

Applicant finds no indication that the Garber system would require determining the order of items in a set in order to determine the identity of a missing item. The cited portion of Garber merely addresses notifying a user that items are out of order when the items are out of algorithm order, and provides no teaching for determining the identity of a missing item. Separately, Garber indicates that a given item may be missing if its unique identifier is not encountered during interrogation.[8] However, the order of other items in a set relative to the missing item is irrelevant to this determination.

Moreover, as described above with respect to claim 83, Garber provides no teaching or suggestion of using the information obtained by the interrogation for performing the determining and updating an inventory database as a background inventory operation. Garber's teaching of allowing a user to input a status of an item requires an independent, active step by the user, and fails to teach or suggest modification of the Garber system to simultaneously use the same information obtained by the interrogation for performing the recited background inventory

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[7] Office Action dated February 20, 2007, at page 13.
[8] *See* Garber, col. 16, ll. 36–55.

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operation. Thus, one of ordinary skill in the art would not have found such a modification of the
Garber system obvious based on the cited teachings of Garber.

Claim 45

With respect to claim 45, the Examiner cited col. 17, ll. 44–53 of Garber, which discusses
programming the RFID device such that upon the RFID device reading several RFID tags that are
indexed to the Adult fiction area, the user is alerted when non-Adult Fiction items are
encountered. The Examiner stated that this teaches determining whether an item represented on
the inventory list as being present is among the items whose RFID tags were interrogated, and
when the item is not among the item whose RFID tags were interrogated, indicating to the user in
real time that the inventory list incorrectly indicates that the item is present. Applicant disagrees
with this conclusion. Garber does not teach indicating to the user in real time that the inventory
list incorrectly indicates that the item is present when the item is not among the item whose
RFID tags were interrogated. Rather, in the example cited by the Examiner, both the Adult
fiction items and the non-Adult Fiction items are among those items whose RFID tags were
interrogated. Garber provides no teaching pertinent to determining that an item, represented on
the inventory list as being present, is not among the items whose RFID tags were interrogated,
indicating the discrepancy, and enabling the user to correct the inventory list in real time. Thus,
even if Garber were modified in the manner suggested by the Examiner, such modification would
still not result in the features of Applicant's invention as claimed in independent claim 45.

Of course, the claims dependent on independent claims 39, 40, 41, and 45 incorporate all
of the limitations of the respective base claims, and therefore are patentable for at least the
reasons expressed above.

For at least these reasons, the Examiner has failed to establish a prima facie case for non-
patentability of Applicant's claims 39–41 and 45–47 under 35 U.S.C. 103(a). Withdrawal of this
rejection is requested.

Claims 48, 49, 95–102

In the Office Action, the Examiner rejected claims 48, 49, 95–98 and 101 under 35
U.S.C. 103(a) as being unpatentable over Garber in view of Frich (US 6,074,156). In the Office
Action, the Examiner rejected claims 99 and 100 under 35 U.S.C. 103(a) as being unpatentable

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over Garber in view of Frich as applied to claim 97 above, and further in view of Barritz et al. (US 2002/0008621). In the Office Action, the Examiner rejected claims 102 under 35 U.S.C. 103(a) as being unpatentable over Garber in view of Frich as applied to claim 97 above, and further in view of Paruliski et al. (US 5,633,678). Applicant respectfully traverses the rejection. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

For example, independent claim 48 recites using an RFID reader to interrogate RFID tags, each associated with an item, wherein the items are not currently located at desired locations in a physical storage area, and the items are not currently arranged or interrogated in an order associated with their desired locations in the physical storage area. Claim 48 further recites the information obtained from the RFID tags is organized in an order in which the items are to be moved from their current location to the desired locations of the items in the physical storage area, and this organized information is presented to a user.

In the Office Action, the Examiner acknowledged that Garber fails to teach or suggest organizing, with the RFID reader, information obtained from the RFID tags in an order in which the items are to be moved from their current locations to their desired locations in the physical storage area. In view of this deficiency, the Examiner cited Frich, stating that Frich teaches that librarian's tasks involve receiving, sorting, and re-shelving returned materials, and that procedures have been developed to provide some degree of automation in these tasks.[9] The Examiner concluded that it would have been obvious to one of ordinary skill in the art in view of Frich to modify the teachings of Garber to provide the correct shelving order.

Applicant disagrees. Frich generally describes mechanically automating tasks of handling printed matter, such as by providing library carts, photocopy collators, and library cart loading systems.[10] Frich fails to address organizing information, let alone organizing, with an RFID reader, information obtained from the RFID tags in an order in which the items are to be moved from their current locations to their desired locations in the physical storage area. The teachings of Frich relied on by the Examiner are therefore insufficient to render obvious the modification

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[9] Office Action dated February 20, 2007, at page 18.
[10] Frich, col. 1–col. 2.

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of Garber proposed by the Examiner. The desirability of such a modification would have been apparent only upon access to Applicant's disclosure, which is impermissible.

Similarly, with respect to independent claim 95, Garber in view of Frich provides no teaching or suggestion of, with a portable RFID reader, obtaining a list of information related to RFID tags organized in the order in which the RFID tags were interrogated, and organizing the information in a different order with the portable RFID reader. The system of Garber need not reorganize information obtained from the tags at all when determining whether particular scanned items are in an algorithm order, and nothing in Garber or Frich suggests that any such reorganization is necessary. Further, as explained above, Frich lacks any teaching of organizing information, let alone with a portable RFID reader.

Of course, the claims dependent on independent claims 48 and 95 incorporate all of the limitations of the respective base claims, and therefore are patentable for at least the reasons expressed above.

For at least these reasons, the Examiner has failed to establish a prima facie case for non-patentability of Applicant's claims 48, 49, and 95–102 under 35 U.S.C. 103(a). Withdrawal of this rejection is requested.

Rejection for Obviousness-type Double Patenting:

The Examiner provisionally rejected claims 1, 3–8, 10–13, 15–24 and 48–49 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 60 and 64–77 of copending Application No. 09/882,969.

Applicant notes the provisional status of these rejections. Accordingly, Applicant will address this issue if and when the rejection is formally applied.

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CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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By:

May 21, 2007

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